

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB 20, 98
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re La Salsa Holding Co.

Serial No. 74/586,109

Michael A. Painter of Isaacman, Kaufman & Painter for La
Salsa Holding Co.

Robert C. Clark, Jr., Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney)

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

La Salsa Holding Co. applied on October 17, 1994 to
register FRESH MEXICAN GRILL on the Principal Register as a
service mark for restaurant services.¹ Exclusive rights to
the word MEXICAN were disclaimed. When the Examining
Attorney refused registration pursuant to Section 2(e)(1) of
the Trademark Act, applicant, on May 15, 1995, amended its

¹ The application claims first use and first use in commerce on
September 30, 1993.

application to seek registration on the Supplemental Register.

Registration has been finally refused on the Supplemental Register pursuant to Section 23 of the Trademark Act, 15 U.S.C. 1091 on the ground that the proposed mark is incapable of identifying applicant's services and distinguishing them from those of others.²

Both applicant and the Examining Attorney have submitted briefs; an oral hearing was not requested.

The Examining Attorney has asserted that FRESH MEXICAN GRILL is generic for restaurant services, and is therefore incapable of distinguishing applicant's services from those of others. Essentially, the Examining Attorney contends that FRESH MEXICAN GRILL refers to a particular type of restaurant, in the same way that "ice cream parlor" or "pizza parlor" does. He further states that FRESH MEXICAN GRILL is generic for Mexican restaurant services which serve fresh food.

² In an earlier Office action the Examining Attorney had taken the position that applicant's mark was not registrable on the Supplemental Register because it did not function as a service mark. That reasoning, as applicant has pointed out, is not applicable to the question of registrability on the Supplemental Register, since to be registrable on that register a mark need only be capable of distinguishing the applicant's goods or services. Although the Examining Attorney could certainly have been clearer in stating the basis for the refusal, applicant has been aware throughout prosecution of the application that capability is the issue in question, and has addressed that as the issue.

In support of his position the Examining Attorney has made of record excerpts from 12 articles taken from the NEXIS database which include the phrase "Fresh Mexican Grill". However, on closer examination, it is clear that in all but 2 of the articles this phrase forms part of the name of a restaurant: five of the articles are about Ramon's Fresh Mexican Grill; three mention Baja Fresh Mexican Grill; and two mention Zuma: A Fresh Mexican Grill. The remaining two articles are also about the Zuma restaurant, and refer to "fresh Mexican grill" in quotes, as follows:

The tasty eats come by way of Zuma (it calls itself "a fresh Mexican grill")
"Rocky Mountain News," November 17,
1995;

The 500 block of Grant Street sports two new eateries, Moe's Broadway Bagel and Zuma, a "fresh Mexican grill."
"Rocky Mountain News," November 10, 1995

The Examining Attorney has also submitted with his brief dictionary definitions of "fresh", ("free from taint: PURE; not altered by processing; not stale, sour, or decayed") and "grill" ("a usu. informal restaurant or dining room esp. in a hotel").³ The Examining Attorney asserts that "fresh" as used in connection with restaurant services is not incongruous.

Finally, the Examining Attorney argues that, as used on the signage for applicant's establishment, FRESH MEXICAN

GRILL "immediately and unmistakably indicates to the relevant public to which the services are directed that applicant is offering a restaurant service which serves fresh Mexican food." Brief, p. 3. This is because the words FRESH MEXICAN GRILL are depicted in block letters under the words LA SALSA, which is shown in stylized letters.

A generic term is incapable of indicating source, and thus is not registrable on the Supplemental Register. It is the Office's burden to show that a mark is generic. **In re Merrill Lynch, Pierce, Fenner and Smith Inc.**, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). We find, on the record presented herein, that the Office has not met its burden of proving that the phrase FRESH MEXICAN GRILL is generic for restaurant services.

The Examining Attorney himself has acknowledged that the NEXIS evidence "is not a very substantial showing of genericness based on the number of occurrences of this term." Brief, p. 5. We would certainly agree that the use of the phrase only in connection with three restaurants is indeed sparse evidence of genericness, particularly since restaurants serving Mexican food have been in existence for a very long time. One would expect that if FRESH MEXICAN GRILL were indeed a generic term for restaurants serving

³ The Board may take judicial notice of dictionary definitions,

Mexican food, more references would have been found in the vast NEXIS database.

Moreover, the references in the NEXIS excerpts which have been made of record must be characterized as ambiguous. FRESH MEXICAN GRILL appears as part of the names of each of the restaurants listed in the excerpts. Thus, one cannot conclusively determine whether the phrase is being used as part of a trademark, rather than as a generic term for the restaurant services. As for the two excerpts where "fresh Mexican grill" is used as a descriptive phrase, the fact that it is set out in quotes suggests that FRESH MEXICAN GRILL is not recognized as a generic term. One would not expect the same use of quotes if the phrase had been "Mexican restaurant," i.e., "The tasty eats come by way of Zuma (it calls itself 'a Mexican restaurant')." "

We agree with the Examining Attorney that FRESH is a not incongruous term to describe food served in a Mexican restaurant. We also acknowledge that consumers, viewing applicant's signage, will immediately understand that applicant offers restaurant services featuring fresh Mexican food. However, the question before us here is not whether FRESH MEXICAN GRILL is merely descriptive of restaurant services. Applicant has in effect conceded this by seeking registration on the Supplemental Register. The question we

and we elect to do so in this case.

must decide is whether the phrase FRESH MEXICAN GRILL is capable of distinguishing applicant's restaurant services from those of others. Although the dictionary definition submitted by the Examining Attorney shows that GRILL per se is generic for restaurant services, and applicant has admitted the generic nature of MEXICAN through its disclaimer of that word, this record does not show that FRESH is a generic term for applicant's services, such that when it is combined with MEXICAN GRILL the term FRESH MEXICAN GRILL as a whole is generic. Cf. **In re Gould Paper Corp.**, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). Nor, as we have stated above, is the evidence with respect to use of the phrase FRESH MEXICAN GRILL sufficient to show that consumers regard this as a generic term for restaurant services.

Although we have found that the phrase FRESH MEXICAN GRILL is, as a whole, capable of identifying applicant's restaurant services and distinguishing them from others, the term GRILL is generic for such services and the refusal of registration for FRESH MEXICAN GRILL must be affirmed absent a disclaimer of that word, in addition to the previously disclaimed word MEXICAN. Accordingly, applicant must submit a disclaimer of MEXICAN GRILL before a registration may issue.

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Decision: The refusal of registration without a disclaimer of MEXICAN GRILL is affirmed. Applicant is allowed thirty days to submit the required disclaimer, following which this decision will be set aside.

E. J. Seeherman

P. T. Hairston

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board